

REMARKS/ARGUMENTS

The claims are 2-6, 8, and 10-12. Independent claim 9 has been canceled in favor of new independent claims 10 and 12. New independent claim 10 is directed to a floor covering device including a profiled cover and a compensating strip. New independent claim 12 is directed to a floor covering device including a profiled cover. Claims 2 and 5 have been amended to depend on new independent claim 10. Claims 2-6 have been amended in view of new independent claim 10. Method claim 7 has been canceled in favor of new independent method claim 11. Method claim 8 has been amended to depend on new independent method claim 11 and has been amended to correspond to new independent method claim 11. Support may be found, *inter alia*, in claims 7 and 9, which have been canceled, and in the drawings. Reconsideration is expressly requested.

The Examiner objected to claim 7 for repeating limitations that were already recited in claim 9 to which claim 7 referred.

In response, Applicant has canceled claim 7 in favor of new

independent method claim 11 which does not refer to claim 9 and which does not refer to any other claim. New independent method claim 11 also does not recite the phrase "areal support". Method claim 8 has been amended to depend on new independent method claim 11.

Accordingly, it is respectfully submitted that the Examiner's objection to claim 7 is overcome and it is respectfully requested that the Examiner's claim objection be withdrawn.

Claims 7 and 9 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement for the term "areal" recited in claims 7 and 9.

In response, without conceding the propriety of the Examiner's position, Applicant has used the phrases "is supported flat over", "can be supported flat over", and "would be supported flat over" in new independent claims 10, 11, and 12, which replace canceled claims 7 and 9, and the term "areal" has been completely removed from Applicant's claims. It is respectfully submitted that Applicant's drawings, for example in FIG. 1, show

contact surfaces of the profiled cover being supported flat over a floor cover segment and supported flat over a compensating strip on opposite sides of a clamping web. The Examiner has also already accepted the phrase of being "supported flat over" as complying with the written description requirement with respect to the groove section of Applicant's claimed profiled cover, as it was recited in claim 9 which has been canceled.

Accordingly, it is respectfully submitted that Applicant's new claims and amended claims fully comply with the written description requirement of 35 U.S.C. § 112, first paragraph, and it is respectfully requested that the Examiner's rejection of the claims on this basis be withdrawn.

The Examiner indicated that claims 5 and 6 contain allowable subject matter; however, the remaining claims were rejected on the basis of the prior art. Specifically, claims 7-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stanchfield U.S. Patent No. 6,860,074*. The remaining rejected claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer U.S. Design Patent No. D 542,941* (claims 2-3) and over *Stanchfield* and

Neuhofer U.S. Design Patent No. D 542,941 and further in view of *Kemper U.S. Patent No. 6,345,480* (claim 4).

The Examiner noted with respect to the rejection of claims 7-8 that the Examiner considered claims 7-8 to be "product-by-process" claims that should be examined according to the features of the final product produced and not merely by the method for producing the product.

The Examiner also responded to Applicant's arguments made in the December 17, 2009 second Preliminary Amendment in RCE by indicating that (1) because the Examiner's basis for the rejection of Applicant's claims, namely that "*a mere reversal of the essential working parts of a device only involves routine skill in the art*", comes from case law, the Examiner's interpretation of case law trumps Applicant's interpretation of the case law, (2) that an Examiner's reason for believing that a device of an application constitutes a mere reversal of working parts does not need to be found in the prior art references cited by that Examiner, (3) that there is nothing structurally about Applicant's profiled cover that would make it less susceptible to breaking because of the groove in it, (4) that Applicant's

arguments, that those of ordinary skill in the art believed having the groove in the profiled cover was disadvantageous, support the Examiner's rejection of the claims as obvious because, according to the Examiner, this belief means that those of skill in the art had already thought to try putting a groove on the underside of the profiled cover, (5) that Applicant's claims are directed to the combination of a profiled cover and a compensating strip so that Applicant's arguments as to the performance of the profiled cover without the compensating strip are irrelevant or are weakened, and (6) that once the parts of the transition molding of *Stanchfield* were rearranged the transition molding of *Stanchfield* would be able to rest on a floor in an areal manner.

Applicant respectfully traverses these rejections in view of the foregoing amendments to the claims, the foregoing new claims, and the following remarks.

Applicant has canceled claim 9 in favor of new independent claims 10 and 12. New independent claim 10 is directed to a floor covering device including a profiled cover and a compensating strip. New independent claim 12 is directed to a

floor covering device including a profiled cover having the same features as the profiled cover recited in claim 12. Claim 7 has been canceled in favor of new independent method claim 11.

As recited in Applicant's new claim 10, Applicant's invention provides a floor covering device including a profiled cover and a compensating strip. The profiled cover is made of an extruded profile and includes a covering flange and at least one clamping web protruding downward from the covering flange and extending in a longitudinal direction of the profiled cover.

As further recited in Applicant's new claim 10, the covering flange has an underside with a first contact surface, a second contact surface, a groove section in the first contact surface, and at least one longitudinal groove in the groove section. The first contact surface extends past the at least one clamping web on a first side of the profiled cover and the second contact surface extends past the at least one clamping web on a second side of the profiled cover. The compensating strip has a tongue and is fastened to the covering flange.

As further recited in Applicant's new claim 10, the at least one longitudinal groove of the profiled cover and the tongue of the compensating strip form a tongue-and-groove joint fastening the compensating strip to the covering flange as the tongue projects into the at least one longitudinal groove and the at least one longitudinal groove retains the tongue. The groove section is supported flat over the compensating strip. The first contact surface is supported flat over the compensating strip. The second contact surface can be supported flat over a floor cover segment.

In this manner, Applicant's invention provides a floor covering device that can be supported flat over both a floor area with an elevated flat floor cover segment and over a compensating strip having a tongue.

It is respectfully submitted that, contrary to the Examiner's position, Applicant's floor covering device as recited in new claim 10 does not merely constitute a mere reversal of the working parts of the floor molding of *Stanchfield* because of those reasons provided previously in the Amendments and Responses already submitted by Applicant for this application.

Moreover, it is respectfully submitted that Applicant's floor covering device as recited in new claim 10 is patentable over *Stanchfield* because *Stanchfield* fails to disclose all of the elements of Applicant's floor covering device as recited in new claim 10.

Applicant's floor covering device as recited in new claim 10, and shown for example in Applicant's FIG. 1, has a covering flange 6 of the profiled cover 4 that on both sides of clamping web 7 has a contact surface on its underside for flat installation on a floor covering, i.e. forms a contact surface for a floor covering.

Specifically, *Stanchfield* fails to disclose such a profiled cover having first and second contact surfaces on an underside of the profiled cover and on both sides of the clamping web that allow flat support of the profiled cover on floor coverings with substantially completely flat top surfaces. The molding device 11 of *Stanchfield* would not be able to be installed on each side of foot 16 on a floor covering with a substantially completely flat top surface, because the tab 18 would interfere so that most of arm 12 of the molding 11 would be elevated above the

substantially completely flat top surface and only the tab 18 would lie flat on the substantially completely flat top surface. The narrow tab 18 would thereby support the entire weight of the arm or covering flange which could cause the narrow tab 18 to prematurely be broken off the arm or covering flange.

In contrast, Applicant's floor covering device as recited in new claim 10 allows the profiled cover to be supported flat over either of a compensating strip having a tongue and an elevated floor covering segment having a substantially completely flat top surface.

Moreover, neither of *Neuhofer, Jr. U.S. D542,942* and *Kemper et al. U.S. Patent No. 6,345,480* remedy the deficiencies of *Stanchfield* with respect to Applicant's new claim 10, because neither of *Neuhofer, Jr.* and *Kemper et al.* discloses a tongue-and-groove joint as recited in Applicant's new claim 10 and neither provides the benefits provided by Applicant's floor covering device as recited in new claim 10. Each of *Neuhofer, Jr.* and *Kemper et al.* fails to disclose any tongue or groove on either of the profiled cover and the compensating strip that interacts with the other of the profiled cover and the

compensating strip.

Accordingly, it is respectfully submitted that Applicant's new claim 10, together with amended claims 2-6 which depend thereon, are patentable over the prior art references cited by the Examiner.

Applicant's floor covering device as recited in new claim 12 provides a profiled cover made of an extruded profile. The profiled cover includes a covering flange and at least one clamping web protruding downward from the covering flange and extending in a longitudinal direction of the profiled cover. The covering flange has an underside with a first contact surface, a second contact surface, a groove section in the first contact surface, and at least one longitudinal groove in the groove section.

As further recited in Applicant's new claim 12, the first contact surface extends past the at least one clamping web on a first side of the profiled cover and the second contact surface extends past the at least one clamping web on a second side of the profiled cover.

As further recited in Applicant's new claim 12, the at least one longitudinal groove of the profiled cover can receive a tongue of a compensating strip to form a tongue-and-groove joint that can fasten the compensating strip to the covering flange as the tongue projects into the at least one longitudinal groove and the at least one longitudinal groove retains the tongue, so that the groove section would be supported flat over the compensating strip and the first contact surface would be supported flat over the compensating strip. The second contact surface can be supported flat over a floor cover segment.

In this manner, Applicant's invention provides a floor covering device that has all of the features of the profiled cover of Applicant's new claim 10 and that can be used with a compensating strip and fixture to provide the benefits achieved by Applicant's floor covering device as recited in new claim 10.

Moreover, Applicant's new claim 12 is directed to a profiled cover and does not specifically include a compensating strip as an affirmative structural element of new claim 12. Nevertheless, new claim 12 specifies that the profiled cover has a groove in its underside which it is respectfully submitted achieves the

surprising result of not being weakened to breaking while versatily allowing the profiled cover to rest on either of the floor and a completely flat elevated floor cover segment. It is respectfully submitted, moreover, that this feature and the surprising result achieved is entirely relevant to Applicant's new claim 12 and supports the patentability of the claim.

Accordingly, it is respectfully submitted that Applicant's floor covering device as recited in new claim 12 is patentable over the cited prior art references for this reason and for those reasons described above with respect to Applicant's new claim 10.

Applicant's new claim 11 provides a method for the production of a floor covering device. The method includes the step of producing an extruded profiled having a profiled cover connected to a compensating strip via a connecting land that serves as a spacer. The method also includes the step of separating the compensating strip from the profiled cover with a separating cut through the connecting land. The profiled cover is suitable without the compensating strip to be employed between a first floor covering having a first height and a second floor covering having a second height equal to the first height.

As further recited in Applicant's new claim 11, the profiled cover has a covering flange and at least one clamping web protruding downward from the covering flange, extending in a longitudinal direction of the profiled cover and suitable for fastening the profiled cover to a fixture. The covering flange has an underside with a first contact surface, a second contact surface, a groove section in the first contact surface, and at least one longitudinal groove in the groove section. The first contact surface extends past the at least one clamping web on a first side of the profiled cover and the second contact surface extends past the at least one clamping web on a second side of the profiled cover.

As further recited in Applicant's new claim 11, the compensating strip includes a tongue for fastening the compensating strip to the covering flange. The at least one longitudinal groove of the profiled cover and the tongue of the compensating strip form a tongue-and-groove joint so that the compensating strip can be fastened to the covering flange. The tongue projects from the compensating strip and is able to project into the at least one longitudinal groove. The at least one longitudinal groove is able to retain the tongue. The groove

section can be supported flat over the compensating strip. The first contact surface can be supported flat over the compensating strip. The second contact surface can be supported flat over a floor cover segment.

In this manner, Applicant's provide a method for producing a floor covering device that can be supported flat over both an elevated floor cover segment that is substantially flat and a compensating strip having a tongue.

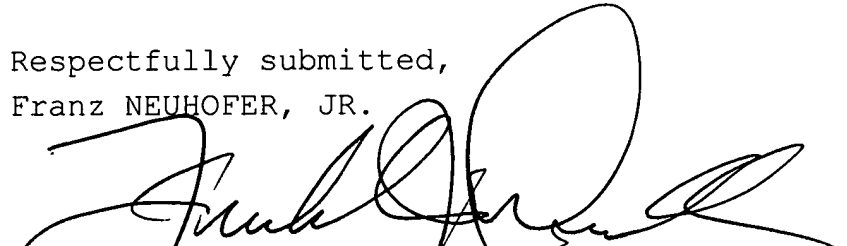
Applicant's method of new claim 11 produces a profiled cover and a compensating strip having the features of the profiled cover and the compensating strip recited in Applicant's new claim 10. Because the prior art references cited by the Examiner fail to disclose and fail to suggest a profiled cover and a compensating strip as recited in new claim 10 for those reasons described above and described in the previous Amendments and Responses of this application, these prior art references also fail to disclose and fail to suggest the method for making a profiled cover and a compensating strip recited in Applicant's new claim 11.

It is also respectfully submitted that Applicant's new independent method claim 11 clarifies that it is a method claim and not a product-by-process claim. Although Applicant's method as recited in claim 11 is directed to a method for producing a floor covering device having the features of the profiled cover and the compensating strip recited in new claim 10, Applicant's new claim 11 does not refer to new claim 10 and does not refer to new claim 12.

Accordingly, it is respectfully submitted that Applicant's new claim 11, and amended claim 8 which depends thereon, are patentable over the prior art references cited by the Examiner.

In summary, claims 2-6 and 8 have been amended, claims 7 and 9 have been canceled, and new claims 10, 11, and 12 have been added. In view of the foregoing, it is respectfully requested that the claims be allowed and that this application be passed to issue.

Respectfully submitted,
Franz NEUHOFER, JR.

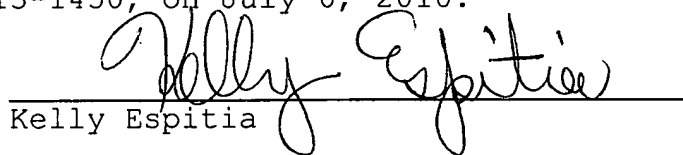


Frederick J. Dorchak, Reg. No. 29,298
Caleb D. Wilkes, Reg. No. 60,873
Attorneys for Applicant

COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802

FJD:cdw

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Kelly Espitia